

REMARKS

Claims 1 through 27 and 29 are pending in this application. Claims 19, 22 through 24 and 26 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application. Claim 29 has been newly added. Claim 28 has been canceled without prejudice or disclaimer of its subject matter. The Applicant appreciates the Examiner's indication of allowability concerning claims 4, 6-8, 10, 11, 14, 16, 17, 22, 23, 24 and 26.

I. CLAIM REJECTIONS - 35 U.S.C. § 102

Claims 19, 20, 21, 25, 27 and 28 were rejected under 35 U.S.C. 102(b) as being anticipated by Outlook.

No claim is anticipated under 35 U.S.C. §102 (b) unless all of the elements are found in exactly the same situation and united in the same way in a single prior art reference. As mentioned in the **MPEP §2131**, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as complete detail as is contained in the patent claim. *Id.*, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165

USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.

In reference to claim 19, the Examiner stated that Outlook discloses continuously determining whether an authorized user requests to view letters addressed to the authorized user (when the user double clicks, the response from the continual monitoring of events of the mouse and keyboard will cause the message to be displayed for the user).

Respectfully, the continuing monitoring of a mouse and keyboard input is not the same as continuously determining whether an authorized user requests to view letters addressed to the authorized user. The present invention is more particular in its instruction. As mentioned above, in a 102 rejection, the limitations must be exactly as arranged in the claim.

This is especially the case since Outlook cannot always process a view of the letters, so entering a key or mouse will not always give a view of the letters. Outlook certainly does not continuously monitor for viewing if for example the user request to view the letters as in certain modes of Outlook cannot receive requests to view the letters.

Furthermore, as amended (including language from claim 28), Outlook does not include *printing the letters corresponding to the image and character data read by said step of reading image and character data.*

Concerning claim 28, the Examiner had mentioned that Outlook discloses the step of viewing the letters and printing a letter corresponding to the data read in said step of reading image and character when the authorized user request to print a letter (the preview option indicated on page 121, allows one to view what is to be printed).

However, the claim is stating that the letters that are viewed are being printed which is different from the letters that are printed are viewable.

Furthermore, looking at page 121 of the Outlook paper, the viewing of a printed matter is not even mentioned. It only shows the dialog box used for printing. Therefore, this does not disclose that the letters which are viewed are printed, it only gives an option of printing messages if a user chooses, but then the user must click on each separate message in order to print which can end up being a cumbersome and long process. So, clearly as claimed, the Outlook paper does not disclose printing letters corresponding to the image and character data that is read.

In reference to claim 27, Outlook does not disclose the step of viewing and printing the letters that are read. Page 121 of the Outlook paper only discloses that a letter can be read. So if a user views a letter, then he can optionally print the letter. However, this does not disclose that the letters that “viewed” are then viewed and printed.

II. REJECTION OF CLAIMS (35 U.S.C. § 103)

Claims 1, 2, 3, 5, 9, 12, 13, 15 and 18 were rejected under 35 USC 103(a) as being unpatentable over No. 5,521,719 to Yamada in view of Outlook.

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner stated that in reference to claims 1, 2 and 18, Yamada discloses an electronic letter receiver (Fig. 9, element 122 for receiving email), where letter came from a mail server (for the case of the email receiver, Fig. 9, element 122, the mail server is Fig. 10, element 138) and Yamada further discloses the letter receiver being attached to a LAN (Fig. 10) wherein a personal computer (Fig. 10, element 135) is attached to the LAN as well as a printer (Fig. 10, element 135 and 140 and the printer can automatically print email based on user's settings (Column 4, lines 15-28).

However, the Examiner explains that Yamada does not expressly disclose a letter storing

unit, display unit, a user interface or a controller as specified in the limitations.

However, the Examiner states that Outlook discloses an application that resides on a personal computer, causing the personal computer to be a letter storing unit accommodating sorting and storing of image and character data by the account of user (when user logs with username and password, messages addressed to him are downloaded to his PC); a display unit (the monitor of the PC) for displaying information extracted from the image and character data; a user interface unit (the Outlook graphic user interface application) outputting a display request signal when an authorized user requests to view a letter addressed to him (display request signal generated by PC upon double clicking, or single click depending on user preferences, on the message in Outlook) and outputting an account control signal (signal causes the retrieval of the message from the mail server in order to be displayed) and Outlook discloses the Outlook application being a controller that outputs email messages to the monitor based on the account user and allows for printing capabilities (page 121, hence generating a print control signal) and Outlook teaches that mail servers have a unique address on a network, where the unique mail address is needed (pages 175-178, defining where the incoming, POP3 and outgoing, SMTP servers are) to communicate with the mail server.

Respectfully, Yamada deals with an "Improved Group 3 Facsimile" as mentioned clearly in the the title of Yamada. The paper of Outlook does not describe a facsimile function and it is well known that Outlook 2000 is not capable of handling facsimiles, but is for e-mails. According to MPEP 706.02(j) there must be a reasonable expectation of success and using Outlook 2000 in Yamada would be a mistake for the manufacturer of Yamada. Therefore, a person of ordinary skill

in the art would not be motivated to combine the Outlook 2000 software with Yamada's group 3 facsimile subaddress communication function.

The Examiner stated that Outlook discloses the Outlook application being a controller that outputs email. However, this logic is, respectfully, incorrect, Outlook the software cannot be *controller* as claimed in an apparatus claim. Outlook is not structurally a controller, it is not an apparatus unit.

The Examiner stated that Outlook the software discloses a a user interface unit (the Outlook graphic user interface application). However, the Outlook paper and the Outlook software is not disclosing a portion of an apparatus which is a user interface unit. A graphical interface of outlook cannot be used in rejecting *user interface unit outputting a display requesting signal*, as Outlook the software cannot by its graphical interface program output a display requesting signal. Respectfully, using Outlook would be an improper rejection of the apparatus claim 1.

In reference to claim 3, the Examiner states that Outlook further disclose requiring a user to login with a username and password so the application can open and output a display request signal for displaying a message on the monitor and account control signal for retrieving messages.

However, claim 3 is mentioning again the user interface unit that outputs display requesting signal and Outlook is only a software with instructional code. No user interface unit in an apparatus is taught or suggested by the Outlook paper.

In reference to claim 5, the Examiner states that the email application is the system program that serves as the controller. Again as shown above, this would respectfully be improper since the controller is a structural apparatus unit.

In reference to claim 9, the Examiner states that Outlook further discloses converting data corresponding to the letter under the control of the software where the data received is converted to different text fonts, sizes, and images based on fields/tags in the receive data.

However, again, control of the software is not necessarily control of the controller unit.

Furthermore, as mentioned in col. 18, lines 5-15, reference 122 of Yamada which the Examiner calls the e-mail unit, reference 122 is being coordinated with the facsimile apparatus and therefore, Outlook would be a big problem when used in Yamada as it cannot handle facimile or interfacing with a facsimile.

III. ALLOWABLE SUBJECT MATTER

The examiner stated that claims 4, 6-8, 10, 11, 14, 16, 17, 22, 23, 24 and 26. would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Following the advice of the examiner, claims 22-24 and 28 were rewritten in independent form including all of the limitation of the base claim and any intervening claims. Therefore, claims 22-24 and 28 should be allowed.

The applicant appreciates the examiner's indication of allowability pertaining to remaining

allowable claims. In accordance with 37 C.F.R. § 1.111(b), the applicant respectfully requests that the examiner temporarily hold objections and requirements as to form in abeyance until the remarks and amendments in this Amendment are considered by the examiner.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

A fee of \$258.00 is incurred by this Amendment by the addition of three (3) independent claims above three (3). Applicant's check drawn to the order of Commissioner accompanies this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



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Date: 2/17/04
I.D.: REB/SS